

NAGACO.074A



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Coombs, et al.)
)
Appl. No. : 10/792,291)
)
Filed : March 2, 2004)
)
For : METHODS AND APPARATUS)
FOR USE IN DETECTION AND)
QUANTIFICATION OF VARIOUS)
CELL TYPES AND USE OF)
OPTICAL BIO-DISK FOR)
PERFORMING SAME)
)
)
Examiner : Unknown)
)
)
Group Art Unit : 1645)

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

10/22/04
(Date)

Russell M. Jelle, Reg. No. 34,198

PETITION TO FILE DECLARATIONS ON BEHALF OF NONSIGNING INVENTORS WHO
REFUSE TO SIGN OR CANNOT BE REACHED UNDER 37 CFR 1.47(A)

Mail Stop Missing Parts
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice to File Missing Parts mailed May 25, 2004, Applicants hereby petition under the provisions of 37 C.F.R. § 1.47(a), that the Commissioner accept for filing and examine the above-identified patent application despite the fact that two of the four joint inventors named in this application have not executed an oath or declaration. Applicants have been unable to secure declarations of inventorship from the nonsigning inventors despite diligent efforts and numerous requests on behalf of the inventors who have executed declarations. In support for this petition, Applicants provide the following:

10/26/2004 RMEBRAHT 00000074 10792291

05 FC:1460

130.00 OP

Appl. No. : 10/792,291
Filed : March 2, 2004

DECLARATION OF INVENTORSHIP

A Declaration of Inventorship, attached herewith, was executed by two of the four inventors, James Howard Coombs and Brigitte Chau Phan, on behalf of themselves and on behalf of the omitted inventors, John Francis Gordon and Joseph Roby I. Urcia, who have not signed the declaration of inventorship despite diligent efforts and numerous requests on behalf of the signing inventors. This partially executed Declaration satisfies the requirement that all available joint inventors must (i) execute an oath or declaration on their own behalf as required by 37 C.F.R. § 1.63 and (ii) execute an oath or declaration on behalf of the nonsigning joint inventor as required by 37 C.F.R. § 1.64, and in accordance with MPEP § 409.03(a) "an oath or declaration signed by all the available joint inventors with the signature block of the non-signing joint inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated."

STATEMENTS OF FACTS

Applicant provides the following declaration, attached herewith, in support of its conclusion that nonsigning inventors refuse to sign and/or cannot be reached:

1. Declaration of Russell Jeide in Support of Petition To File Declaration On Behalf Of Nonsigning Inventors Who Refuse to Sign or Cannot Be Reached Under 37 CFR 1.47(a).

The Declaration shows the efforts of Applicants to contact the nonsigning inventors by email, telephone, and U.S. Mail to obtain their cooperation.

LAST KNOWN ADDRESS OF THE NONSIGNING INVENTORS

The last known address of John Francis Gordon is: 20 New Jersey, Irvine, CA 92606. Mr. Gordon is a citizen of the United Kingdom.

The last known address for Joseph Roby I. Urcia is: 8511 Marion Ave., Westminster, CA 92683. Mr. Urcia is a United States citizen.

CONCLUSION

Based on the foregoing, it is submitted that diligent efforts has been made to obtain a signature for the Declaration of Inventorship from both John Francis Gordon and Joseph Roby I.

Appl. No. : **10/792,291**
Filed : **March 2, 2004**

Urcia. Despite these diligent efforts, Applicants have not been able to obtain a declaration from either Mr. Gordon or Urcia. Applicants submit that the remaining joint inventors, James Howard Coombs and Brigitte Chau Phan, make the application for patent on behalf of themselves and on behalf of the omitted inventors, John Francis Gordon and Joseph Roby I. Urcia, in accordance with 37 C.F.R. § 1.47 (a). Furthermore, Applicants respectfully submit that the Declaration of Inventorship executed by two of the four named inventors satisfies the requirement that all available joint inventors (i) make oath or declaration on their own behalf as required by 37 C.F.R. § 1.63 and (ii) make oath or declaration on behalf of the nonsigning joint inventor(s) as required by 37 C.F.R. § 1.64.

Applicants respectfully request that this petition under 37 C.F.R. §1.47(a) be granted and that the Applicants be allowed to file and prosecute the above-identified patent application without the signature of Mr. Gordon or Urcia. If there are any obstacles to a prompt approval of this petition, the Patent and Trademark Office is invited to call the undersigned attorney.


Respectfully submitted,

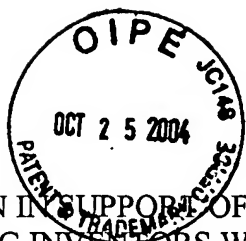
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

10/22/04

By: _____


Russell M. Jeide
Registration No. 54,198
Attorney of Record
Customer No. 20,995
(619) 235-8550



DECLARATION IN SUPPORT OF PETITION TO FILE DECLARATION ON BEHALF
OF NONSIGNING INVENTORS WHO REFUSE TO SIGN OR CANNOT BE REACHED
UNDER 37 CFR 1.47(A)

I, Russell M. Jeide, hereby declare that, to the best of my knowledge, information, and belief, the following is true, accurate, and correct:

- 1) I am an associate attorney at Knobbe, Martens, Olson & Bear, LLP ("KMOB") and help coordinate prosecution of patent matters assigned to our client, Nagaoka and Co., LTD ("Nagaoka").
- 2) On November 4, 2003, Burstein Technologies, Inc. ("BTI") sold an undivided partial ownership interest in all intellectual property matters to Nagaoka. Prior to November 4, 2003, BTI terminated all employees.
- 3) On March 2, 2004, a patent application was filed on behalf of Nagaoka, titled "Methods and Apparatus for Use in Detection and Quantification of Various Cell Types and Use of Optical Bio-Disc for Performing Same." This application claims priority to a provisional application that was subject to the November 4, 2003 assignment from BTI to Nagaoka. Accordingly, the listed inventors were previous employees of BTI.
- 4) This application was assigned Application Number 10/792,291 ("the '291 application") by the U.S. Patent and Trademark Office, and claims priority to U.S. provisional application number 60/451,587, filed on March 3, 2003.
- 5) On or about May 25, 2004 the U.S. Patent and Trademark Office mailed a Notice To File Missing Parts Of Nonprovisional Application, indicating that the filing fee and an Oath or Declaration were missing from the original application filing. The missing parts notice set a two month initial deadline for submitting the missing declaration and filing fee. Thus, the initial deadline for filing these documents was July 25, 2004.
- 6) After filing the application, I attempted to contact each of the inventors to secure their signatures on a declaration for the '291 application. I did receive executed declarations from two of the four listed inventors, James Howard Coombs and Brigitte Chau Phan. As outlined below, however, despite diligent efforts I was unable to secure executed declarations from John Francis Gordon and Joseph Roby I. Urcia.

Diligent Efforts Attempting to Secure a Declaration of Inventorship from Mr. Gordon

- 7) On or about April 19, 2004 I placed a telephone call to Mr. Gordon and left a message on his answering machine in order to confirm his address information, notify him that the '291 application had been filed, and request his review of the application and execution of a declaration of inventorship. I did not receive a return call from Mr. Gordon.
- 8) On or about June 16, 2004, I placed a subsequent telephone call to Mr. Gordon. This time I was able to speak to Mr. Gordon, who informed me that he may be inclined to sign the declaration of inventorship because he liked the Director and General Manager of Nagaoka, Mr. Ryosuke Nagaoka, but that he thought his former employer Richard Burstein, the co-founder and CEO of BTI, should "jump in a lake." Mr. Gordon stated that he would call Mr. Nagaoka to discuss the status of the '291 application.

- 9) On or about June 16, 2004, I sent an email to Mr. Gordon. Attached to that email was a copy of the '291 application and a declaration of inventorship for the '291 application. I indicated in the email that Mr. Gordon's signature is needed on the declaration to complete the '291 application and that he should sign and date these documents and return them to me. I did not receive a response from Mr. Gordon.
- 10) On or about July 8, 2004, I again emailed Mr. Gordon notifying him that the July 25, 2004, deadline for submitting the declaration of inventorship was approaching and that his cooperation would be greatly appreciated. I did not receive a response from Mr. Gordon.
- 11) On or about August 16, 2004, I prepared and sent a letter to Mr. Gordon, including a copy of the '291 application and a corresponding declaration of inventorship for Mr. Gordon's signature. The letter was sent via U.S. Certified Mail, and a return receipt indicates that the letter was delivered on August 30, 2004. However, I received no response from Mr. Gordon. A copy of the return receipt signed by "John Gordon" is attached hereto as Exhibit A.
- 12) On or about August 25, 2004, I placed another telephone call to Mr. Gordon and left a message on his answering machine asking him to complete the declaration of inventorship. I did not receive a return call from Mr. Gordon.
- 13) On or about September 9, 2004, I sent another email to Mr. Gordon asking him whether he intended to complete the declaration of inventorship that was both mailed and emailed to him previously. I did not receive a response from Mr. Gordon.

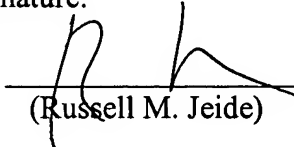
Diligent Efforts Attempting to Secure a Declaration of Inventorship from Mr. Urcia

- 14) On or about June 16, 2004, I placed a telephone call to Mr. Urcia in order to confirm his address information, notify him that the '291 application had been filed, and request his review of the application and execution of a declaration of inventorship. A woman who answered said Mr. Urcia was not home and she hung up on me. I did not receive a response from Mr. Urcia.
- 15) On or about June 21, 2004, I prepared and sent a letter to Mr. Urcia, including a copy of the '291 application and a corresponding declaration of inventorship for Mr. Urcia's signature. The letter was sent via U.S. Certified Mail, and a return receipt indicates that the letter was delivered on July 16, 2004. However, I received no response from Mr. Urcia. A copy of the return receipt signed by "Joseph I. Urcia" is attached hereto as Exhibit B.
- 16) On or about July 8, 2004, I placed another telephone call to Mr. Urcia. A child answered the phone and said Mr. Urcia was at work until 8:00 P.M. and that he does not have the number to reach Mr. Urcia at work. I did not receive a response from Mr. Urcia.
- 17) On or about July 14, 2004, I placed another telephone call to Mr. Urcia. A woman answered the telephone and, after I introduced myself, she hung up the phone. I immediately called back and a person claiming to be a visitor of Mr. Urcia stated that Mr. Urcia was at work and that he did not know where he worked or how to get in contact with him. I did not receive a response from Mr. Urcia.
- 18) On or about July 14, 2004, I prepared and sent a letter to Mr. Urcia, including a copy of the '291 application and a corresponding declaration of inventorship for Mr. Urcia's signature. The letter stated that Mr. Urcia's signature is needed on the declaration to complete the '291 application and that he should sign and date these documents and return them to me. The

letter was sent via U.S. Certified Mail, and a return receipt indicates that the letter was delivered on July 16, 2004. However, I received no response from Mr. Urcia. A copy of the return receipt is attached hereto as Exhibit B.

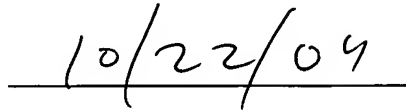
- 19) On or about October 19, 2004, I received the results of a skip trace that was performed by KMOB's in-house researchers. These results located the same address and phone number for Mr. Urcia that I had previously used in attempting to contact Mr. Urcia.

Signature:



(Russell M. Jeide)

Date:



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101804



SENDER: COMPLETE THIS SECTION		COMPLETE THIS SECTION ON DELIVERY	
<ul style="list-style-type: none">Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.Print your name and address on the reverse so that we can return the card to you.Attach this card to the back of the mailpiece, or on the front if space permits.		<p>A. Signature <i>X John Gordon</i> <input type="checkbox"/> Agent <input type="checkbox"/> Addressee</p> <p>B. Received by (Printed Name) C. Date of Delivery</p> <p>D. Is delivery address different from item 1? <input type="checkbox"/> Yes <input type="checkbox"/> No YES, enter delivery address below:</p>	
1. Article Addressed to <div>Mr. John F. Gordon 20 New Jersey Irvine, CA 92606</div>		Service Type <input checked="" type="checkbox"/> Certified Mail <input type="checkbox"/> Express Mail <input type="checkbox"/> Registered <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> Insured Mail <input type="checkbox"/> C.O.D.	
2. Article Number (Transfer from service label)		4. Restricted Delivery? (Extra Fee) <input type="checkbox"/> Yes	
PS Form 3811, August 2001		Domestic Return Receipt	
7004 0750 0002 8442 8302		102595-02-M-1540	
NAGACO 074A		RMJ	

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PS Form 3800, June 2002 See Reverse for Instructions	

Knobbe Martens Olson & Bear LLP

Intellectual Property Law



FILE

550 West C Street
Suite 1200
San Diego CA 92101
Tel 619-235-8550
Fax 619-235-0176
www.kmob.com

Russell M. Jeide
rjeide@kmob.com

August 16, 2004

VIA CERTIFIED MAIL – RETURN RECEIPT

Mr. John F. Gordon
20 New Jersey
Irvine, CA 92606

Re: U.S. Patent Application
Title: METHODS AND APPARATUS FOR USE IN DETECTION AND
QUANTITATION OF VARIOUS CELL TYPES AND USE OF OPTICAL BIO-
DISC FOR PERFORMING SAME
Application No.: 10/792,291 - Filed: March 2, 2004
Our Reference No.: NAGACO.074A

Dear John:

This letter is a follow-up to my e-mails of June 16 and July 8, 2004, and our several phone conversations regarding Nagaoka patent matters.

As you are aware, you are listed as an inventor on a provisional application title, "METHODS AND APPARATUS FOR USE IN DETECTION AND QUANTITATION OF VARIOUS CELL TYPES AND USE OF OPTICAL BIO-DISC FOR PERFORMING SAME," which was filed in the U.S. Patent Office on March 3, 2003. In order to maintain a priority claim to this provisional application, we have filed a corresponding non-provisional application on March 2, 2004. Attached are the specification and figures for the patent application that was filed on March 2, 2004, which may be referenced using our docket no. NAGACO.074A.

In order to complete the filing of the above-listed application, we are required to submit certain formal documents to the U.S. Patent Office, each requiring your signature. These documents include (1) a declaration indicating that you are an inventor of the specific invention embodied in the attached specification and figures and (2) an assignment that transfers all rights in this application to BTI. Please note that, while notarization of the assignment is preferred, it is not required. If a notary is easily accessible, we will gladly reimburse you for their fee.

Orange County
949-760-0404

San Francisco
415-954-4114

Los Angeles
310-551-3450

Riverside
951-781-9231

San Luis Obispo
805-547-5580

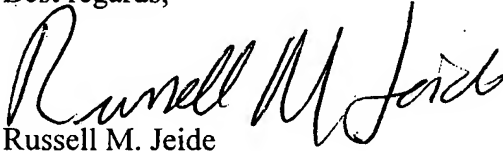
Mr. John F. Gordon

August 16, 2004

Page 2 of 2

Please review the attached declaration and assignment to ensure that they are accurate. You may then execute each document and return to me via (FAX: 619-235-0176), email (such as in a scanned PDF file), or U.S. Mail. We look forward to receiving the completed documents discussed above. If you have any questions, please contact me.

Best regards,



Russell M. Jeide

Enclosures

Certified Mail No.

7004 0750 0002 8442 8319

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Application No.: 10/792,291
Filing Date: March 2, 2004

PATENT
Client Code: NAGACO.074A
Page 1

ASSIGNMENT

WHEREAS, We, James H. Coombs, a citizen of U.K., residing at 175 San Leon Villa, Irvine, CA 92606, John F. Gordon, a citizen of U.K., residing at 20 New Jersey, Irvine, CA 92606, Brigitte C. Phan, a citizen of U.S.A., residing at 171 Stonecliffe Aisle, Irvine, CA 92612, and Joseph R. I. Urcia, a citizen of U.S.A., residing at 8511 Marian Avenue, Westminster, CA 92683, have invented certain new and useful improvements in METHODS AND APPARATUS FOR USE IN DETECTION AND QUANTITATION OF VARIOUS CELL TYPES AND USE OF OPTICAL BIO-DISC FOR PERFORMING SAME for which we have filed an application for Letters Patent in the United States, Application No. 10/792,291, filed on March 2, 2004;

AND WHEREAS, BURSTEIN TECHNOLOGIES, INC. (hereinafter "ASSIGNEE"), a Delaware Corporation, with its principal place of business at 163 Technology Drive, Suite 200, Irvine, CA 92618, desires to acquire the entire right, title, and interest in and to the said improvements and the said Application:

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to me in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said inventors, do hereby acknowledge that we have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEE, its successors, legal representatives and assigns, the entire right, title, and interest throughout the world in, to and under the said improvements, and the said application and all provisional applications relating thereto, and all divisions, renewals and continuations thereof, and all Letters Patent of the United States which may be granted thereon and all reissues and extensions thereof, and all rights of priority under International Conventions and applications for Letters Patent which may hereafter be filed for said improvements in any country or countries foreign to the United States, and all Letters Patent which may be granted for said improvements in any country or countries foreign to the United States and all extensions, renewals and reissues thereof; and we hereby authorize and request the Commissioner of Patents of the United States, and any Official of any country or countries foreign to the United States, whose duty it is to issue patents on applications as aforesaid, to issue all Letters Patent for said improvements to the said ASSIGNEE, its successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND WE DO HEREBY sell, assign, transfer, and convey to ASSIGNEE, his successors, legal representatives, and assigns all claims for damages and all remedies arising out of any violation of the rights assigned hereby that may have accrued prior to the date of assignment to ASSIGNEE, or may accrue hereafter, including, but not limited to, the right to sue for, collect, and retain damages for past infringements of the said Letters Patent before or after issuance.

AND WE HEREBY covenant and agree that we will communicate to the said ASSIGNEE, its successors, legal representatives and assigns, any facts known to us respecting said improvements, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid the said ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper patent protection for said improvements in all countries.

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this ____ day of _____, 20__.

James H. Coombs

STATE OF }
 }
COUNTY OF } ss.

On _____, before me, _____, personally appeared James H. Coombs personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]

Notary Signature

Application No.: 10/792,291
Filing Date: March 2, 2004

PATENT
Client Code: NAGACO.074A
Page 2

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this _____ day of _____, 20__.

John F. Gordon

STATE OF }
 }
COUNTY OF } ss.

On _____, before me, _____, personally appeared John F. Gordon personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in her authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]

Notary Signature

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this _____ day of _____, 20__.

Brigitte C. Phan

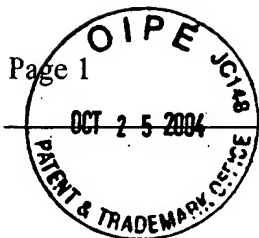
STATE OF }
 }
COUNTY OF } ss.

On _____, before me, _____, personally appeared Brigitte C. Phan personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that she executed the same in her authorized capacity(ies), and that by her signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]

Notary Signature



DECLARATION - USA PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, mailing address and citizenship are as stated below next to my name;

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled METHODS AND APPARATUS FOR USE IN DETECTION AND QUANTITATION OF VARIOUS CELL TYPES AND USE OF OPTICAL BIO-DISC FOR PERFORMING SAME; the specification of which was filed on March 2, 2004, as Application Serial No. 10/792,291.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above;

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56;

I hereby claim the benefit under Title 35, United States Codes § 119(e) of the United States provisional application listed below:

Application No.: 60/451587

Filing Date: March 3, 2003

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of first inventor: **James H. Coombs**

Inventor's signature _____

Date _____

Residence: 175 San Leon Villa, Irvine, CA 92606

Citizenship: U.K.

Mailing Address: Same

Full name of second inventor: **John F. Gordon**

Inventor's signature _____

Date _____

Residence: 20 New Jersey, Irvine, CA 92606

Citizenship: U.K.

Mailing Address: Same

Full name of third inventor: **Brigitte C. Phan**

Inventor's signature _____

Date _____

Residence: 171 Stonecliffe Aisle, Irvine, CA 92612

Citizenship: U.S.A.

Mailing Address: Same



SENDER: COMPLETE THIS SECTION		COMPLETE THIS SECTION ON DELIVERY	
<ul style="list-style-type: none">Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.Print your name and address on the reverse so that we can return the card to you.Attach this card to the back of the mailpiece, or on the front if space permits.		<p>A. Signature: <i>[Signature]</i> <input type="checkbox"/> Agent <input checked="" type="checkbox"/> Addressee</p> <p>B. Received by (Printed Name): <i>[Name]</i></p> <p>C. Date of Delivery: <i>9-16-04</i></p> <p>D. Is delivery address different from item 1? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No If YES, enter delivery address below:</p>	
1. Article Addressed to: <div>Joseph R. I. Urcia 8511 Marion Avenue Westminster, CA 92683</div>		3. Service Type: <input checked="" type="checkbox"/> Certified Mail <input type="checkbox"/> Express Mail <input type="checkbox"/> Registered <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> Insured Mail <input type="checkbox"/> C.O.D.	
2. Article Number (Transfer from service label)		4. Restricted Delivery? (Extra Fee) <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	
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PS Form 3811, February 2004 Domestic Return Receipt 102595-02-M-1540

7003 3110 0005 9963 6713

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Total Postage & Fees	\$

PS Form 3800, June 2002 See Reverse for Instructions

Knobbe Martens Olson & Bear LLP

Intellectual Property Law



URGENT

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San Diego CA 92101
Tel 619-235-8550
Fax 619-235-0176
www.kmob.com

Russell M. Jelde
rjelde@kmob.com

REMINDER

7-14-04
~~June 21, 2004~~

FILE COPY

Joseph R. I. Urcia
8511 Marion Avenue
Westminster, CA 92683

Re: U.S. Patent Application
Title: METHODS AND APPARATUS FOR USE IN DETECTION AND
QUANTITATION OF VARIOUS CELL TYPES AND USE OF OPTICAL BIO-
DISC FOR PERFORMING SAME
Application No.: 10/792,291 - Filed: March 2, 2004
Our Reference No.: NAGACO.074A

Dear Mr. Urcia:

As you know, Nagaoka and Co., LTD is a partial owner of all intellectual property (including unfilled and pending patent applications, as well as issued patents) that were previously owned exclusively by Burstein Technologies, Inc. ("BTI"). As partial owner, Nagaoka is handling filing of new patent applications and maintaining those pending application. Our firm, Knobbe, Martens, Olson & Bear, LLP, has been retained by Nagaoka to handle these matters on their behalf.

You are listed as an inventor on a provisional application title, "METHODS AND APPARATUS FOR USE IN DETECTION AND QUANTITATION OF VARIOUS CELL TYPES AND USE OF OPTICAL BIO-DISC FOR PERFORMING SAME," which was filed in the U.S. Patent Office on March 3, 2003. In order to maintain a priority claim to this provisional application, we have filed a corresponding non-provisional application on March 2, 2004. Attached are the specification and figures for the patent application that was filed on March 2, 2004, which may be referenced using our docket no. NAGACO.074A.

In order to complete the filing of the above-listed application, we are required to submit certain formal documents to the U.S. Patent Office, each requiring your signature. These documents include (1) a declaration indicating that you are an inventor of the specific invention embodied in the attached specification and figures and (2) an assignment that transfers all rights in this application to BTI. Please note that, while notarization of the assignment is preferred, it is not required. If a notary is easily accessible, we will gladly reimburse you for their fee.

Please review the attached declaration and assignment to ensure that they are accurate. You may then execute each document and return to me via (FAX: 619-235-0176), email (such as in a scanned PDF file), or U.S. Mail. We look forward to receiving the completed documents discussed above. If you have any questions, please contact me.

Best regards,



Russell M. Jeide

Enclosures

S:\DOCS\RMJ\RMJ-3818.DOC:gem062104